

REMARKS

Applicant respectfully requests reconsideration of this application, and reconsideration of the Office Action dated June 20, 2003 (Paper No. 9). Upon entry of this Amendment, claims 1-15 will remain pending in this application. Claims 1-11 are withdrawn. The amendments to the claims and the newly added claims are fully supported by the specification and original claims. Moreover, the amendments to independent claim 12 are not narrowing amendments and thus are in no way intended to narrow the original scope of claim 12. No new matter is incorporated by this Amendment.

Applicants wish to thank Examiner Arnold for the courtesies extending to Applicant and Applicant's representatives during the interview of September 9, 2003. Applicant has amended claim 12 by removing the phrase "hygienically acceptable." Moreover, as discussed below, the claims recite structural limitations which clearly distinguish over the cited prior art.

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Claims 7, 9, and 11 are rejected under 35 U.S.C. § 112, second paragraph, as purportedly indefinite. Applicant traverses.

The Office Action asserts the phrase "that is hygienically acceptable for contact with food products" is indefinite because it is unclear for whom it is acceptable or for what kind of food it is acceptable. In response, Applicant has removed the phrase from the claims.

The Office Action further asserts claims 14 and 15 are process claims and fail to further limit the claims from which they depend. The Office Action also asserts the terminology "the food product" in claims 14 and 15 lacks proper antecedent basis. Applicant respectfully disagrees.

Claims 14 and 15 are not process claims but describe structural features of the claims and thus do further limit the claims from which they depend. Moreover, claims 14 and 15 have been amended to further clarify that they are not process claims. For example, claim 14 describes an embodiment of the present invention wherein the cut in the second layer is located in the second layer such that two flaps are formed that, when folded, are intermediately juxtaposed. In other words, claims 14 and 15 further describe structural features of the second layer as a result of the location of the longitudinal cut. With respect to antecedent basis, Applicants have removed the reference to "food product" from claims 14 and 15.

Applicant respectfully submits the above remarks overcome this rejection. Hence, reconsideration and withdrawal of the rejection are respectfully requested.

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Claims 12-15 are rejected under 35 U.S.C. § 103(a) as purportedly obvious based on Spiegel et al. (U.S. Pat. No. 3,764,002). The Office Action asserts Spiegel teaches each element of the claimed invention, except the foldable free flap provided by cutting a tubular sleeve of the plastic second layer. However, the Office Action concludes that this feature of the claimed invention would have been obvious to those of ordinary skill in the art. Applicant respectfully traverses.

Independent claim 12 is drawn to a composite double-layer packaging material. The packaging material includes a first paper support layer, and a second layer adhered to the first layer so as to form a double-layer sheet, wherein the second layer is formed of a thin tubular film of plastic material. The thin film has a transversal dimension not smaller than a transversal dimension of the first paper support layer, such that the thin film

overlays the first paper support layer to form the double-layer sheet. The thin film also has a longitudinal cut so as to form at least one foldable free flap.

As conceded in the Office Action, Spiegel fails to teach each and every feature of the claimed invention. Applicant respectfully submits that Spiegel not only fails to teach or fairly suggest each and every feature of the claims, but Spiegel also fails to provide the requisite motivation to those of ordinary skill in the art to modify the claimed invention as suggested in the Office Action. Spiegel discloses a card package comprising a card and a heat shrinkable tube. The card package disclosed by Spiegel is used to hold containers, such as a bottle. In Spiegel's invention, a shrinkable tube is adhered to a rigid card, a bottle is then placed in the shrinkable tube, and heat is applied to the shrinkable tube to cause the tube to shrink around the bottle. The product of Spiegel is used for suspending a container. This is completely different from Applicant's invention. Applicant's invention comprises a paper support layer to which a second layer including a thin tubular film of plastic is adhered. The second plastic layer is cut in a longitudinal direction such that at least one foldable free flap is formed.

Applicant's invention does not use a heat shrinkable tube for supporting a product to be displayed (such as a bottle). In contrast, Applicant's invention employs a thin film of plastic into which a food product can be placed. In Applicant's invention, after the food product has been placed on the thin film of plastic, the at least one foldable free flap can be used to cover the food product. Thus, Applicant's invention can be used by the retailer to package food on site.

Applicant also respectfully disagrees with the assertion in the Office Action that the teachings of Spiegel would have rendered it obvious to cut the plastic layer. As discussed above, Spiegel's invention employs heat shrinkable plastic which forms around

the object which it holds. Contrary to the assertion in the Office Action, nothing in Spiegel would have suggested to those of ordinary skill in the art that the Spiegel arrangement is at all useful if the shrink-wrap plastic has been cut as called for by claim 12. Rather, cutting the heat shrinkable plastic would destroy the invention of Spiegel for its intended purpose. The M.P.E.P. teaches, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. 2143.01. Applicant thus submits that the alleged prior art Spiegel fails to provide the requisite motivation to those of ordinary skill in the art to modify the teachings of Spiegel as suggested in the Office Action.

To establish a *prima facie* case of obviousness, the Examiner must provide factual support from the cited patents for the proposed modification or combination. This factual support must be based on objective evidence of record and must establish that the cited patent itself provides the requisite motivation, suggestion, or teaching regarding the desirability of making the specific combination made by the Applicant. The factual question of motivation is material to patentability, and can not be resolved on subjective belief and unknown authority. It is improper to determine whether a person of ordinary skill would have been led to modify the prior art based upon hindsight. In re Sang Su Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

In view of the above remarks, Applicant submits that the rejection is overcome. Hence, reconsideration and withdrawal of the amendment is respectfully requested.

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Applicant respectfully submits that this Amendment and the above remarks obviate the outstanding objection and rejections in this case, thereby placing the

application in condition for immediate allowance. Allowance of this application is earnestly solicited.

If any fees under 37 CFR §§1.16 or 1.17 are due in connection with this filing, please charge the fees to Deposit Account No. 02-4300; Order No. 033819.003.

If an extension of time under 37 CFR § 1.136 is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The extension fee should be charged to Deposit Account No. 02-4300; Order No. 033819.003.

Respectfully submitted,

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